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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/808,763	03/24/2004	Kevin J. Lee	42P6148D	5901
8791	7590	01/16/2007	EXAMINER	
BLAKELY SOKOLOFF TAYLOR & ZAFMAN 12400 WILSHIRE BOULEVARD SEVENTH FLOOR LOS ANGELES, CA 90025-1030			ZHENG, LOIS L	
			ART UNIT	PAPER NUMBER
			1742	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/16/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	10/808,763	LEE, KEVIN J.
	<b>Examiner</b>	<b>Art Unit</b>
	Lois Zheng	1742

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### **Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1)  Responsive to communication(s) filed on 24 March 2004.

2a)  This action is **FINAL**.                            2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

4)  Claim(s) 1-7 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5)  Claim(s) \_\_\_\_\_ is/are allowed.

6)  Claim(s) 1-7 is/are rejected.

7)  Claim(s) \_\_\_\_\_ is/are objected to.

8)  Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on \_\_\_\_\_ is/are: a)  accepted or b)  objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)  The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a)  All b)  Some \* c)  None of:  
1.  Certified copies of the priority documents have been received.  
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1)  Notice of References Cited (PTO-892)  
2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3)  Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 3/24/04.

4)  Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_ .  
5)  Notice of Informal Patent Application  
6)  Other: \_\_\_\_ .

## DETAILED ACTION

### ***Status of Claims***

1. Claims 1-7 are currently under examination.

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-7 are rejected under 35 U.S.C. 102(b) as being anticipated by Gealer et al. US 4,765,865(Gealer).

Gealer teaches an electroetching apparatus selectively removing a conductive layer from a wafer substrate via a mask(abstract). The electroetching apparatus of Gealer comprises a potentiostat(Fig. 2 #22) having three terminals each connected to a counter electrode(Fig. 2 #10), a working electrode couple to the substrate(Fig. 2 #9) and a reference electrode(Fig. 2 #23) respectively, Gealer further teaches a reaction vessel storing the electrolyte and housing the wafer substrate, the counter electrode and the reference electrode that are immersed in the electrolyte(Fig. 2 # 13).

Regarding claim 1, Gealer teaches all the components of the claimed apparatus. In addition, the claimed substrate having sub-micron interconnect features does not lend patentability to the instantly claimed apparatus since the substrate is directed to a subject that is worked on by the claimed apparatus. It is well settled that "expressions relating the apparatus to contents thereof during an intended operation are of no

significance in determining patentability of the apparatus claim". Ex parte Thibault, 164 USPQ 666, 667 (Bd. App. 1969). Furthermore, "[i]nclusion of material or article worked upon by a structure being claimed does not impart patentability to the claims." In re Young, 75 F.2d \*996, 25 USPQ 69 (CCPA 1935) (as restated in In re Otto, 312 F.2d 937, 136 USPQ 458, 459 (CCPA 1963)). See MPEP 2115 [R-2].

Furthermore, the claim recitation of how the potential difference between the substrate and the reference electrode is maintained and when the selective removal of conductive layer is ended does not lend patentability to the instant apparatus claims since they are directed to how the claimed apparatus is being operated. It is well settled that a claim containing a "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus" if the prior art apparatus teaches all the structural limitations of the claim. Ex parte Masham, 2 USPQ2d 1647 (Bd. Pat. App. & Inter. 1987). See MPEP 2114. Since the recited process limitations do not structurally differentiate the claimed apparatus from the apparatus of Gealer, the recited process limitations do not render the instant claim patentable.

The examiner also maintains a position that the apparatus of Gealer is inherently capable of performing in the claimed fashion.

Regarding claim 2, the apparatus of Gealer is capable of varying a current between the substrate and the counter electrode to maintain the potential different at a fixed value as claimed (col. 5 lines 40-43).

Regarding claims 3-7, the claimed conductive layer, barrier layer and the sub-micron interconnect features are directed to the wafer substrate which is worked on by the claimed apparatus. Therefore, these claim limitations does not lend patentability to the instant apparatus claims for the same reasons as stated in the rejection of claim 1 above. See MPEP 2115 [R-2].

4. Claims 1-7 are rejected under 35 U.S.C. 102(b) as being anticipated by Nojiri et al. US 5,173,149(Nojiri).

Nojiri teaches an electroetching apparatus for selectively removing a conductive layer from a wafer substrate(abstract). The electroetching apparatus of Nojiri comprises a potentiostat(Fig. 5 #21) having three terminals each connected to a counter electrode(Fig. 5 #4), a working electrode couple to the substrate(Fig. 5 #3) and a reference electrode(Fig. 5 #22) respectively, Nojiri further teaches a reaction vessel storing the electrolyte and housing the wafer substrate, the counter electrode and the reference electrode that are immersed in the electrolyte(Fig. 5 #1-2).

Regarding claim 1, Nojiri teaches all the components of the claimed apparatus. In addition, the claimed substrate having sub-micron interconnect features does not lend patentability to the instantly claimed apparatus since the substrate is directed to a subject that is worked on by the claimed apparatus. It is well settled that “expressions relating the apparatus to contents thereof during an intended operation are of no significance in determining patentability of the apparatus claim”. Ex parte Thibault, 164 USPQ 666, 667 (Bd. App. 1969). Furthermore, “[i]nclusion of material or article worked upon by a structure being claimed does not impart patentability to the claims.” In re

Young, 75 F.2d \*>996<, 25 USPQ 69 (CCPA 1935) (as restated in *In re Otto*, 312 F.2d 937, 136 USPQ 458, 459 (CCPA 1963)). See MPEP 2115 [R-2].

Furthermore, the claim recitation of how the potential difference between the substrate and the reference electrode is maintained and when the selective removal of conductive layer is ended does not lend patentability to the instant apparatus claims since they are directed to how the claimed apparatus is being operated. It is well settled that a claim containing a "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus" if the prior art apparatus teaches all the structural limitations of the claim. *Ex parte Masham*, 2 USPQ2d 1647 (Bd. Pat. App. & Inter. 1987). See MPEP 2114. Since the recited process limitations do not structurally differentiate the claimed apparatus from the apparatus of Nojiri, the recited process limitations do not render the instant claim patentable.

The examiner also maintains a position that the apparatus of Nojiri is inherently capable of performing in the claimed fashion.

Regarding claim 2, the apparatus of Nojiri is capable of varying a current between the substrate and the counter electrode to maintain the potential different at a fixed value as claimed (col. 3 lines 11-28).

Regarding claims 3-7, the claimed conductive layer, barrier layer and the sub-micron interconnect features are directed to the wafer substrate which is worked on by the claimed apparatus. Therefore, these claim limitations does not lend patentability to

the instant apparatus claims for the same reasons as stated in the rejection of claim 1 above. See MPEP 2115 [R-2].

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lois Zheng whose telephone number is (571) 272-1248. The examiner can normally be reached on 8:30am - 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Roy King can be reached on (571) 272-1244. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

LLZ

*R*  
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